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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,399	10/31/2001	Roger Bruce Harding	1313/1H506-US1	1039

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EXAMINER	
KHARE, DEVESH	

ART UNIT	PAPER NUMBER
1623	

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/002,399	HARDING ET AL.	
	Examiner	Art Unit	
	Devesh Khare	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-97* is/are pending in the application.

4a) Of the above claim(s) *1-41,46-60,62-73 and 75-84* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *42-45,61,74 and 85-97* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/18/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's Amendment and remarks filed on 08/16/2004 are acknowledged. Claims 1-97 are pending. Claims 85-93 have been amended. New claims 94-97 have been added. Claims 42-45, 61, 74 and 85-97 are currently at issue in this application. The rejection of claims 42-45 under 35 U.S.C., 102(b), has been withdrawn in view of applicant's remarks that "it is the product of the process recited in the claim, not the product made by any process".

IDS dated 06/18/2003 has been considered. The terminal disclaimer dated 8/16/2004 has been entered.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 42-45, 85-93 and newly added claims 94-97 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of prior U.S. Patent No. 6,686,464('464). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 42-45 and 85-97 of this application and claims 1-4 of '464 are both directed to a pulp derived

carboxymethyl cellulose (cellulose ether) having a significantly higher viscosities. The claims differ in that:

Claims 42-45 and 85-97 recite "A carboxymethyl cellulose from mercerized and recovered cellulose pulp". Claims 42-45 and 85-97 cannot be considered patentably distinct over claims 1-4 of prior U.S. Patent '464 when there is a specifically disclosed pulp derived carboxymethyl cellulose (cellulose ether) having a solution viscosity of from 60,000 to about 100,000 cP (claims 1-4) wherein the cellulose pulp is altered by mercerizing and recovering cellulose pulp preferably containing at least about 20% by weight of cellulose II (col. 5, lines 62-67) before preparing the carboxymethyl cellulose and falls within the scope of claims 42-45 and 85-97 of the present application.
The examiner notes the instant claims and the '464 claims do indeed substantially overlap and this obviousness-type double patenting rejection is necessary to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 61 and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by Morse (U.S. Patent 4,269,859) of record.

Claims 61 and 74 are drawn to a cellulose floc. It is noted that each of claims 61 and 74 is a product-by-process claim.

Morse discloses the cellulose floc granules and process (see abstract). Morse discloses the cellulose floc granules and their characteristics in examples 11-13 (see cols. 6 and 7). Therefore Morse's cellulose flocs are seen to anticipate applicants' claimed invention.

The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Rejection Maintained

Rejection of claims 61 and 74 under 35 U.S.C. 102(b) is maintained for the reasons of record.

Response to Arguments

Applicant's arguments filed on 08/16/04 traversing the rejection of claims 61 and 74 under 35 U.S.C 102(b) have been fully considered but they are not persuasive.

Applicants argue "cellulose floc prepared from mercerized and recovered cellulose pulp exhibits a significantly greater dry floc density that that prepared from unmercerized

pulp, as in Morse." Applicants have not set forth dry floc density limitation of the products in the claim to distinguish them over the art of record

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Devesh Khare whose telephone number is 571-272-0653. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Supervisory Patent Examiner, Art Unit 1623 can be reached at 571-272-0661. The official fax phone numbers for the organization where this application or proceeding is assigned is (703) 308-4556 or 308-4242.
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Devesh Khare, Ph.D.,JD.
Art Unit 1623
November 4,2004